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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,387	04/11/2001	Louiss R. Jackson, JR.	COMP:0205	4526

7590 11/04/2003
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EXAMINER

VORTMAN, ANATOLY

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/832,387	JACKSON,, LOUISS R.	
	Examiner	Art Unit	
	Anatoly Vortman	2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. The submission of the amendment filed on 09/15/03 is acknowledged. At this point claims 1, 21, 37, and 46 have been amended and claim 51 has been cancelled. Thus, claims 1-50 are pending in the instant application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-18, 20-32, 34-42, and 44-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by DE/29,616,175.

DE/29,616,175 disclosed (Fig. 1-4) a space saving system as claimed in claims 1-18, 20-32, 34-42, and 44-50 of the instant application, including a personal computer (sec translation, p. 2, lines 20, 21; p. 3, lines 7-12; p. 7, lines 12+).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19, 33, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE/29,616,175 as applied to claims 1, 21, and 37 respectively, in view of US/5,610,798 to Lochridge.

DE/29,616,175 disclosed all of the claims limitations, but did not disclose that upright surface (wall) mounting (mount structure (5)) comprises a plurality of keyhole slots.

Lochridge disclosed a hangable computer (Fig. 2) having a mounting for hanging (40) comprising a plurality of keyhole slots (46) in order to readily hang or remove the computer from supporting surface without the removal of holding screws (column 5, lines 10+).

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to substitute the mount structure (5) of DE/29,616,175 with the plurality of the keyhole slots as taught by Lochridge in order to facilitate hanging and removal of the device from supporting surface.

6. Alternatively, claims 1-50, are rejected under 35 U.S.C. 103(a) as being unpatentable over US/5,375,076 to Goodrich et al., (Goodrich) in view of DE/29,616,175.

Regarding claims 1, 2, 12, 19, 21, and 37, Goodrich disclosed (Fig. 14-17) a computing apparatus, comprising:

a personal computer including: a housing (20) configured for a display (26) and a plurality of computing electronic devices (42, 44, 46), wherein the display (26) is coupled to a side of the housing (20) and the housing (20) has a slim thickness; and a mounting assembly (36) for the housing (20) configured to facilitate a desired upright orientation of the display (26) and a shallow horizontal space consumption of the housing (20), but did not disclose a mount structure configured to mount the housing on a substantially vertical surface (wall).

DE/29,616,175 disclosed a hangable computer (Fig. 1-4) including display (1), the computer/display having a mount structure (5) configured to mount said display on a vertical surface (wall) in order to save the working surface space.

Since the inventions of Goodrich and of DE/29,616,175 are from the same field of endeavor (computer displays), the purpose of the mount structure configured to mount said display on a vertical surface as taught by DE/29,616,175 would be recognized in the invention of Goodrich.

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to supplement said display of Goodrich with the mount structure as taught by DE/29,616,175 in order to facilitate mounting of the display of Goodrich on the vertical surface in order to save the space on a working surface.

Regarding claims 3, 8, 9, 10, 22, 23, and 38, Goodrich disclosed that the housing (20) embodies a substantially flat panel having a flat display screen (26) with a viewable area configured for personal computer system, (Fig. 14, 16, 17).

Regarding claim 4, 6, 7, 25, 26, 40, and 41, Goodrich disclosed that said housing (20) comprising a plurality of modular bays (receptacles) for at least a portion of a portable (desktop) computer component (42, 44, 46), (Fig. 14).

Regarding claim 5, Goodrich disclosed a slot (covered by door (40)) for a compact computer component (column 4, lines 51+).

Regarding claim 11, Goodrich disclosed a display angle adjustment assembly (36) coupled to the housing (20) for orienting the display in a desired viewing angle, (Fig. 9).

Regarding claims 13, 14, and 28, Goodrich disclosed a motherboard (52) with a processor (inherited in the structure, since any computer has a processor).

Regarding claim 15, Goodrich disclosed a data storage device (44).

Regarding claims 16, 29, and 42, Goodrich disclosed a battery (i.e. a mobile computer component), (50), (Fig. 13).

Regarding claims 17 and 31, Goodrich disclosed a port (48) configured for communication with an external electronic device.

Regarding claims 18 and 32, Goodrich disclosed a wireless communication assembly for interacting with peripheral devices (column 4, lines 12+).

Regarding claims 20, 34, and 44, Goodrich disclosed a horizontal mount structure (36) for mounting the housing (20) on a substantially horizontal surface.

Regarding claims 24, 27, and 39, Goodrich disclosed compact computer modular devices (bodies) (42, 44) adapted for removable insertion into, and coupling with, the housing (20).

Regarding claim 30, Goodrich disclosed that the computing devices comprise software (column 4, lines 32+).

Regarding claim 36, Goodrich disclosed a keyboard (24) for communicatively coupling to a port (28) of the housing (20).

Regarding claims 35 and 45, Goodrich disclosed a wall mountable (inherently) peripheral device (24) configured for communicatively coupling to a port (28) of the housing (20), (Fig. 17).

Regarding the functional recitation "wall mountable", please note that it is narrative in form, since anything can be mounted to the wall. In order to be given a proper patentable weight, a functional recitation must be expressed as a "means" for performing the specified function (i.e. a specific structure which would allow the device to be readily mounted to the wall), as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claims 46-51, the method steps recited in the claims are necessitated by the device structure as disclosed by Goodrich in view of DE/29,616,175.

Claims 19, 33, and 43, are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodrich in view of DE/29,616,175 as applied to claims 1, 21, and 37 respectively, and further in view of US/5,610,798 to Lochridge.

Goodrich in view of DE/29,616,175 disclosed all of the claims limitations, but did not disclose that upright surface (wall) mounting (mount structure (5) of DE/29,616,175) comprises a plurality of keyhole slots.

Lochridge disclosed a hangable computer (Fig. 2) having a mounting for hanging (40) comprising a plurality of keyhole slots (46) in order to readily hang or remove the computer from supporting surface without the removal of holding screws (column 5, lines 10+).

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to substitute the mount structure (5) of DE/29,616,175 in combination of Goodrich and DE/29,616,175 with the plurality of the keyhole slots as taught by Lochridge in order to facilitate hanging and removal of the device from supporting surface.

Response to Arguments

7. Responding to the Applicant's request, the English language translation of DE/29616175 is provided herein.

Regarding the 35 USC 102 rejection, the main thrust of the Applicant's arguments is directed to the assertion that DE/29616175 does not teach a personal computer.

On the contrary, the Examiner believes that DE/29616175 does teach a personal (notebook) computer specifically adapted for use as an electronic display device (see translation, p. 2, lines 20, 21; p. 3, lines 7-12; p. 7, lines 12+).

Furthermore, the Examiner has cited the following definition of **"personal computer"** from IEEE 100 The Authoritative Dictionary of IEEE Standards Terms (p. 812, column 2): "*a single-user microcomputer designed for personally controllable applications.*"

The Examiner believes that device of DE/29616175 is perfectly satisfies the aforementioned definition as well as the definition cited in the Applicant's remarks. Indeed, the

electronic display device taught by DE/29616175 is built around standard personal notebook computer (see above) and may be employed by a single user (a person) for personally controllable application (i.e. for displaying pictures or text) in business or office environment, for example during presentations (see translation, "Description", lines 1+, following the title of the invention).

Also, contrary to the Applicant's assertion that DE/29616175 device is "merely "depicts static and /or dynamic images and / or text which are preferably constructed as files on a separate computer system" (see p. 11 of the Applicant's remarks), the Examiner would like to direct the Applicant's attention to Fig. 3 of DE/29616175 reference, which depicts the device comprising all necessary components of the computer in a portable package (i.e. adapted for use by a single user (person)): a processor (12), a graphic processor (13), a keyboard (17), a memory (14), a fixed-disk (hard drive) (15), a floppy drive (4), ports (16), a data interface (18), CD-ROM drive (19), a display (1, 6, 7), etc., all assembled in a personal-computer-type housing (2).

In view of the above, the Examiner would like to reiterate that device taught by DE/29616175 is a personal computer specifically adapted for use as an electronic display device.

Regarding the 35 USC 103 rejection, the main thrust of the Applicant's arguments is directed to the assertion that references used in the rejection have been improperly combined and that there was no motivation to combine said references.

On the contrary, the Examiner would like to direct the Applicant's attention that motivations have been explicitly articulated in the bodies of the rejections (see p. 3 of the outstanding Office Action, paragraph # 5, lines 7, 8, 11, and 12; p. 4, lines 12-15, 18, and 19; p. 7, lines 2, 3, and 7).

Also, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

Also, the Examiner believes that one of ordinary skill in the computer art would have been motivated at the time the invention was made to combine teachings of the references used in 35 USC 103 rejections, because said person of ordinary skill in the art would have been reasonably expecting the success of the resulted combination. Indeed, as decided in *In re O'Farrel*, 7 USPQ 2d, 1673-1681, Fed. Cir. 1988, obviousness does not require absolute predictability of success. For many inventions that seem quite obvious, there is no absolute predictability of success until the invention is reduced to practice. There is always at least a possibility of unexpected results, that would then provide an objective basis for showing that the invention, although apparently obvious, was in law nonobvious. *In re Merck & Co.*, 800 F.2d at 1098, 231 USPQ at 380; *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1461, 221 USPQ 481, 488 (Fed. Cir. 1984); *In re Papesch*, 315 F.2d 381, 386-387, 137 USPQ 43, 47-48 (CCPA 1963). For obviousness under 35 U.S.C. 103, all that is required is a reasonable expectation of success. *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645,

651-652 (Fed. Cir. 1985); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Responding to the Applicant's position, that the Examiner utilized the "hindsight reconstruction" while rejecting the claims under 35 USC 103 (p. 14, lines 11+ of the Applicant's remarks), please note that it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Also, contrary to the Applicant's position that "the Examiner's statement may be taken as Official Notice..." (p. 18, lines 10, 11 of the Applicant's remarks), please note that the Examiner has not taken the Official Notice in the instant case.

In response to the Applicant's remarks directed to the patentable weight of the functional language (see p. 19 of the Applicant's remarks), the Examiner would like to clarify his position regarding the functional language in general:

The functional limitations of the claim is given their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application only if said functional limitations invoke 35 U.S.C. 112, sixth paragraph.

(See *Donaldson*, 16 F.3d at 1194, 29 USPQ2d at 1850 (stating that 35 U.S.C. 112, sixth paragraph "merely sets a limit on how broadly the PTO may construe means-plus-function language under the rubric of reasonable interpretation.")).

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets

the following 3-prong analysis:

- (A) the claim limitations must use the phrase “means for ” or “step for ”;
- (B) the “means for ” or “step for ” must be modified by functional language;
and
- (C) the phrase “means for ” or “step for ” must not be modified by sufficient structure, material or acts for achieving the specified function.

With respect to the first prong of this analysis, a claim element that does not include the phrase “means for” or “step for” will not be considered to invoke 35 U.S.C. 112, sixth paragraph.(MPEP ¶ 2181).

In the instant case, since claims functional limitations (i.e. “wall mountable”) do not include the phrase “means for” or “step for” said functional limitations have not been considered to invoke 35 U.S.C. 112, sixth paragraph, i.e. they have not been interpreted by the Examiner in light of and consistent with the written description of the invention in the application.

Furthermore, since claim’s functional limitations in the instant case did not invoke 35 U.S.C. 112, sixth paragraph, the only venue for the Examiner to give the aforementioned functional limitations patentable weight would have been to find in the claims a sufficient structure in support of said functional limitations (as decided in *In re Fuller*) which claims failed to provide.

Therefore, since claims functional limitations (i.e. “wall mountable”) did not invoke 35 U.S.C. 112, sixth paragraph and did not satisfy *In re Fuller*, those functional limitations have not been given patentable weight.

In conclusion, regarding the rejections of the claims 19, 33, and 43, the Applicant's arguments that "The Lochridge reference explicitly *teaches away* from integrating a display with the computer body" (p. 24 of the Applicant's remarks, lines 5, 6) are believed to be irrelevant to the rejections of said claims 19, 33, and 43. The only teachings which have been taken by the Examiner from Lochridge reference are those directed to the use of a plurality of the keyhole slots for hanging the computer (see outstanding Office Action, p. 7, lines 1+) not the teachings of "integrating a display with the computer body" (see Applicant's remarks, p. 24, lines 5, 6) as it has been suggested by the Applicant.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2835

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824. The examiner can normally be reached on Monday-Friday, between 9:30am and 6:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

A handwritten signature in black ink, appearing to read "A. Vortman", with a stylized flourish at the end.

Anatoly Vortman
Primary Examiner
Art Unit 2835

A.V.